

**REMARKS**

Claims 1-14, 21 and 23-25 remain pending in this application, all of which stand rejected.

Based on the foregoing amendments and following remarks, entry of this amendment and reconsideration and allowance of this application is respectfully requested.

**Drawing Objections**

The drawings stand objected as not being of sufficient quality for publication. Because this application was filed before November 29, 2000, and will thus not be published, Applicant requests that the drawing objections be held in abeyance until the application has been allowed.

**Claim Rejections-35 U.S.C. §112**

Claim 14 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, the Examiner states that the phrase “coordinate value resulting from spatially locating the mark” lacks antecedent basis. In accordance with the Examiner’s suggestion, claim 14 was amended to refer to “relocating the mark.” Thus, Applicant believes that the Examiner’s indefiniteness rejection of claim 14 has been cured, and as such, respectfully requests withdrawal of the §112 rejection of this claim.

**Claim Rejections-35 U.S.C. §103**

**Gibbs**

The Examiner has maintained the rejection of claims 1-3, 5, and 7-8 under 35 U.S.C. §103 as being obvious over U.S. Patent No. 5,000,554 to Gibbs (“Gibbs”). Applicant respectfully traverses this rejection, since Gibbs does not disclose, teach, or suggest the combination of elements required by these claims.

In particular, the Examiner states that the Applicant's distinction of the claimed invention based on the fact that "there is no suggestion in Gibbs that the location of an area of interest requires any automated verification" fails, because the "claim language does not appear to recite this feature." To the extent that the Examiner means from this statement that Gibbs cannot be distinguished on this basis because the claim language does not recite that the area of interest must require verification, whether automated or otherwise, Applicant submits that Gibbs can be successfully distinguished without having to include in the claim language why one would not be motivated to modify Gibbs in a particular manner. To the extent that the Examiner means from this statement that Gibbs cannot be distinguished on this basis because the claim language does not require the verification to be automated, Applicant submits that the Examiner's characterization of Applicant's argument in this respect is oversimplified and taken out of the context. That is, it is clear from of the paragraph bridging pages 6 and 7 of the previous amendment and response that Applicant was stating that, taking the Examiner's position as set forth in the previous Office Action that the area of interest is already verified, there is no suggestion to verify the area of interest in Gibbs again whether it is automated or not.

In fact, the Examiner's reading of Gibbs that the mere relocation of an area of interest at a position that approximates the original location of the area of interest constitutes a verification of that area of interest is in error. Relocation of an area of interest is not the same as verifying the area of interest simply because a machine attempts to relocate the area of interest at its originally determined position. As made clear in the present application, and as established by the prior art, stage movement and loading of slides is imperfect, often resulting in substantial errors. Thus, merely because a machine is designed to relocate an area of interest at its originally determined position, as with all automated microscopes, does not mean that the area of interest is verified.

Even assuming that the mere relocation of an area of interest constitutes a verification of that area of interest, which it clearly does not, the Examiner has not explained why one of ordinary skill in the art would be motivated to verify the area of interest again using the claimed verification means. If, instead, it is the Examiner's position that Gibb's disclosed means of "verifying" the area of interest (i.e., that an area of interest can be verified simply by relocating it) would actually be replaced with the claimed means for verifying the area of interest, so that the area of interest would only be verified once, it would not make logical sense, since the entire premise of Gibbs is to be capable of relocating an area of interest.

In response to Applicant's argument that the Examiner's obviousness findings were conclusory, the Examiner states that the motivation to modify Gibbs "would have been to provide the capability of highly accurate locating and relocating of microscope objects of interest in the sample." However, this is not Applicant's point, since it is clear from the background of the present application that accuracy in locating and relocating microscope objects is desirable. Rather, the point is that, even if there is some suggestion to modify the Gibbs to verify an area of interest on the slide, there is no suggestion or motivation to modify the Gibbs device so that it verifies the area of interest in the manner required by the claim, i.e., based on a dimensional error between the location and relocation of a datum mark on the slide.

In fact, this feature is nowhere disclosed or suggested in Gibbs, and the only place where it is found is in the specification of the application. As the Examiner surely knows, in determining whether such suggestion or motivation exists in the prior art, he cannot benefit from impermissible hindsight vision afforded by the claimed invention. In particular:

Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to

“hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (M.P.E.P. §2142) (emphasis added).

In rejecting claims 1-3, 5, and 7-8 as being obvious over Gibbs alone, Applicant can only conclude that the Examiner improperly used the disclosure of the present application for the teaching that it would have been obvious to modify the Gibbs device to verify an area of location based on the dimensional error between the location and relocation of a datum mark on the slide. If the Examiner believes otherwise, he is requested to point out where in the prior art this missing feature is disclosed or suggested.

Thus, Applicant submits that independent claim 1, as well as the claims depending therefrom (claims 3, 5, and 7-8), are not obvious over Gibbs, and as such, respectfully request withdrawal of the §103 rejections of these claims.

#### Gibbs and Kamentsky

The Examiner has maintained the rejection of claims 4, 6, and 9 under 35 U.S.C. §103 as being obvious over Gibbs in combination with U.S. Patent No. 5,587,833 (“Kamentsky”). Applicant respectfully traverses this rejection, since neither Gibbs nor Kamentsky, alone or in combination, disclose, teach, or suggest the combination of elements required by these claims. In particular, Kamentsky does not supplement the lack of teaching in Gibbs that the verification of the location of an area of interest be based on the dimensional error between datum mark measurements.

Thus, Applicant submits that claims 4, 6, and 9 are not obvious over the combination of Gibbs and Kamentsky, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Gibbs and Ortyn

The Examiner has maintained the rejection of claims 10-14, 20-21, and 23-25 under 35 U.S.C. §103 as being obvious over Gibbs in combination with U.S. Patent No. 5,499,097 (“Ortyn”). Applicant respectfully traverses this rejection, since neither Gibbs nor Ortyn, alone or in combination, disclose, teach, or suggest the combination of elements required by these claims.

In particular, the teaching of Ortyn is limited to calibration slides, and the Examiner failed to explain why one of ordinary skill in the art, after reading Ortyn, would modify the Gibbs device to verify the area of interest based on the spatial offset value between the location and relocation of a datum mark on an actual biological slide. As previously stated, Ortyn states nothing about verifying an area of interest on a biological slide, but rather testing the repeatability of stage movement. In attempting to combine Gibbs and Ortyn, the Examiner states that it is Gibbs that suggests the desirability of verifying the area of interest. However, this does not explain why one would be motivated to combine the teachings of Ortyn, which says nothing about verifying locations of interest, with the teachings of Gibbs to make the claimed invention. There is nothing in Ortyn to tie the act of locating and relocating a datum mark disclosed therein with the result of verifying an area of interest on a biological slide. As previously stated, at the most, Ortyn suggests that the Gibbs device can be modified so that it can test the repeatability of its stage movement using datum marks on a calibration slide. Such modification, however, does not result in the verification of an area of interest on the biological slide.

The suggestion to combine Gibbs and Ortyn in the manner contemplated by the Examiner can only come from the specification of the present application, which Applicant has previously explained is impermissible. As such, Applicant requests the Examiner not to work backwards from the claimed invention in combining Gibbs and Ortyn, but rather to review Gibbs and Ortyn as a

whole, and work forward from there to determine whether there is a fair suggestion to combine these references to make the claimed invention. As just explained, however, there is no such suggestion.

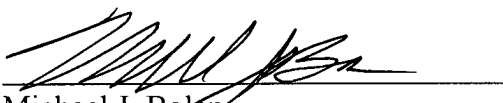
Thus, Applicant submits that independent claims 10, 14, and 20, as well as the claims depending therefrom (claims 11-13, 21, and 23-25), are not obvious over the combination of Gibbs and Ortyn, and as such, respectfully request withdrawal of the §103 rejections of these claims.

#### Conclusion

Based on the foregoing, it is believed that, with entry of this amendment, all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (714) 830-0600.

Respectfully submitted,

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